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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,291	04/19/2001	Chin Tae Kim	P-204	9587
34610	7590	04/07/2006		
FLESHNER & KIM, LLP P.O. BOX 221200 CHANTILLY, VA 20153			EXAMINER OYEBISI, OJO O	
			ART UNIT 3628	PAPER NUMBER
DATE MAILED: 04/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,291

Applicant(s)

KIM ET AL.

Examiner

OJO O. OYEBISI

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-29 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-29, and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In the Amendment filed on 01/10/06, the following have occurred: Claims 1, 3-20 and 26 have been amended, claims 2 and 30-33 have been canceled. Claims 1, 3-29 and 34 remain pending in the present application, and due to the applicant's amendment, the examiner has withdrawn the 35 U.S.C. 101 rejection of claims 1-3, 5-6, and 12, and 35 U.S.C. 112 rejection of claims 8-12. However, claims 1, 3-29 and 34 stand rejected in this office action.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 20-26, 28-29, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by DE LA MOTTE et al (DE hereinafter, U.S PUB. No.: 2003/0014318).

Re claim 20. DE discloses a method of matching vendors to buyers through a network, comprising: identifying whether vendors (i.e., suppliers) satisfy minimum attributes set by a buyer (i.e., suppliers are evaluated and rated in accordance with the standardized rating system, see abstract, also see "remote buyers can develop RFQ's defining both the objective configurations (i.e., product type,

package size, quantity, delivery requirements, etc.) and subjective characteristics (i.e., flavor, aroma, texture, etc.) of the product. The buyer then sends the RFQ to the transaction facilitator for presentation to suppliers located throughout the world. In response, interested suppliers may develop quotations (also referred to herein as quotes or bids) to provide the product specified in the RFQ for a particular price. The suppliers' bids are sent to the transaction server subsystem for presentation to the buyer, who may accept a bid or make a counter-offer", see paras 0031-0032)); registering the vendors (i.e., suppliers) that satisfy the minimum attributes (see paras 0029-0030); identifying the buyer's vendor selection criteria (i.e., RFQ's, see paras 0013-0014); notifying the vendors of the vendor selection criteria (i.e., the buyer sends RFQ's for presentation to the suppliers, see paras 0031-0032); accepting bids from vendors (see paras 0031-0032); and selecting by the buyer a selected vendor from the vendors that satisfy minimum attributes according to one or more of the vendor selection criteria (i.e., buyers can activate software filters to screen offers based on product type, supplier, country of origin, etc. When a buyer finds an offer of interest, the buyer can either accept the offer or submit a counter-offer for presentation to the supplier, see paras 0032-0033).

Re claim 21. DE further discloses the method of matching vendors to buyers through a network, wherein the selection criteria comprises geographic region, business type or price (i.e., buyers can activate software filters to screen offers based on product type, supplier, country of origin, etc, see paras 0032-0033, also

see paras 0021-0022).

Re claim 22. DE further discloses the method of matching vendors to buyers, further comprising notifying the selected vendor of having been selected (i.e., Once the buyer accepts the supplier's bid or counter-offer, an acceptance is transmitted to the supplier and the transaction proceeds toward completion, paras 0048-0049).

Re claim 23. DE further discloses the method of matching vendors to buyers through a network wherein the notification is through one of e-mail, file transfer protocol, integration technology, DCOM, XML, CORBA, HTTP, wireless devices or instant messaging (i.e., In any event, the RFQ is sent to each of the appropriate suppliers via the Internet such as by instant messaging, e-mail, see paras 0040-0041)

Re claim 24. DE further discloses the of matching vendors to buyers through a network, wherein the buyer provides the vendor selection criteria (i.e., RFQ's) and a database stores registered vendors that satisfy minimum attributes (see paras 0029-0030).

Re claim 25. DE further discloses the method of matching vendors to buyers through a network, wherein the buyer is prompted to input selection criteria through one or more capture forms (i.e., purchase order, see paras 0049-0050).

Re claim 26. DE further discloses a network based sales generation system, comprising: a spatial location engine (i.e., transaction facilitator) to determine criteria of a buyer and attributes of a plurality of vendors (i.e., Once a substantial

number of RFQ's or bids are submitted to the transaction facilitator, the system can build a profile defining what most buyers and suppliers consider to be minimally acceptable levels of quality, see paras 0074-0075); a registering unit to register vendors which satisfy set minimum attributes (see paras 0029-0030); a database containing information regarding the registered vendors (i.e., supplier registration database, see paras 0040-0041); an analyzing unit to collect selection criteria from the buyer (i.e., transaction server subsystems, see paras 0040-0041, also see 0045-0046); and an engine to automatically select a qualified vendor for the buyer based on the database information and the selection criteria (i.e., software filter, see paras 0032-0033).

Re claim 28. DE further discloses the network based sales generation system as further comprising: a vendor notification unit to notify registered vendors of selection criteria entered by the buyer (see paras 0046-0047); and a bid accepting unit to receive bids from the registered vendors (see paras 0045-0046), wherein the bids are stored in the database (see paras 0034-0035), wherein one of the bids and the selection criteria are capable of being jointly tendered by a plurality of cooperating parties (i.e., the remote terminals of buyers, suppliers, and third-party service providers, allows the establishment of a global, virtual marketplace for negotiating and executing sales of goods and services, see paras 0052-0053)

Re claim 29. DE further discloses the network based sales generation system as wherein the analyzing unit comprises a dynamically generated application form to

be completed by the buyer and submitted to the engine (i.e., RFQ), wherein the spatial location engine and the database use the data from the completed dynamically generated application form to select at least one qualified vendor (see paras 0040-0045).

Re claim 34. DE further discloses a method for selecting a first party for a second party for engaging in a transaction, comprising: means for entering a request identifying at least one criterion for a transaction by the second party through a network (i.e., RFQ module in the transaction serve subsystem, see paras 0097-0102); means for qualifying the first party to a set of minimum attributes (i.e., Once a substantial number of RFQ's or bids are submitted to the transaction facilitator, the system can build a profile defining what most buyers and suppliers consider to be minimally acceptable levels of quality, see paras 0074-0075); means for identifying a qualified first party to engage in the transaction based on at least one criterion(see abstract, also see software filter paras 0032-0033) ; means for providing an identification of the first and second parties to engage in the transaction(i.e., Preferably, each buyer, supplier, and third-party service provider gains access or "membership" to system 100 by registering with the system operator, the system operator typically will collect information regarding the identity of the participant, the party's financial information, the goods/services in which the participant trades, and etc, see paras 0029-0030).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the applicant's disclosure (see background of the invention).

Re claims 1, 3-19. The applicant makes the following disclosure in the background of the invention "In a tender purchasing method in the related art, a company or an agency gives a public notice of a tender content such as an item, a tender method, tender date, tender place, or required documents, etc. After that, the responses to the tender are screened by hand, a bidder is selected on the basis of the screening result, and an order is placed. Recently, the purchasing technology has been applied to the internet where a notice of tender is performed and tender documents are received over the internet. In other words, the notice of tender or documents acceptance, etc. performed by hand in the tender purchasing method in the related art is performed using the internet." Since Claims 1-19 merely recites the automation of the manual purchasing method stated supra, merely providing an automatic means to replace a manual activity (i.e., paper process) which accomplishes the same result is not sufficient to distinguish over the prior art, In re Venner, 262 F.2d 91, 120 USPQ 193, 194 (CCPA 1958). In other words, there is no enhancement found in the claimed step

other than the known advantage of increased speed/efficiency. The end result is the same as compared to the manual method (i.e., ink and paper process). It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the recited steps in claims 1-19 because this would speed up the determining steps which is purely known and expected result from automation of what is known in the art.

5. Claims 27 rejected under 35 U.S.C. 103(a) as being unpatentable over DE.
Re claim 27. DE does not explicitly disclose the network based sales generation system wherein the registering unit comprises a dynamically generated application form to be completed by a vendor and compared to the set minimum attributes and stored in the database if the vendor meets or exceeds the minimum attributes. However, DE discloses registering with the system operator wherein the system operator typically will collect information regarding the identity of the participant, the party's financial information, the goods/services in which the participant trades, and etc (see paras 0029-0030), and this information may be stored in one or more databases. It is well known in the art that when data are stored in the database, they are usually stored in database query forms. Thus, it would been obvious to one of ordinary skill in the art to generate this form automatically using the system of DE in order for buyers and suppliers to have easy access the forms and to the data contained therein.

Response to Arguments

6. Applicant's arguments filed 01/10/06 have been fully considered but they are not persuasive.

Regarding the rejection of claims 1, 3-19 based on the applicant's disclosure in the background of the invention, the applicant argues in substance that *In re Venner* was inappropriately applied to establish the obviousness of automation of a known process. As the applicant states, "In a tender purchasing method in the related art, a company or an agency gives a public notice of a tender content such as an item, a tender method, tender date, tender place, or required documents, etc. After that, the responses to the tender are screened by hand, a bidder is selected on the basis of the screening result, and an order is placed. Recently, the purchasing technology has been applied to the internet where a notice of tender is performed and tender documents are received over the internet. In other words, the notice of tender or documents acceptance, etc. performed by hand in the tender purchasing method in the related art is performed using the internet" (see applicant's background of the invention, pgs 1-2). In the instant case, all the tender purchasing method/process described are considered old and well known in the art (i.e., paper process as evidenced by the applicant's assertion in the remarks, pg 17 lines 9-10), and utilizing a computer system to automate a known manual/paper process is old and well in the art.

What distinguishes the applicant's invention from the calculators, computers, robotics, and manufacturing machines inventions is that the applicant

is broadly automating a known method utilizing a known and existing technology. The applicant is not claiming specific features or structures that make the automation possible, nor is the applicant providing any innovation to the method for which innovation is sought (e.g., the applicant clearly states that "the manual process discussed in Applicants' background was not merely a paper process, but many times involved the negotiation between parties (buyer and seller) that is time-consuming", see the remarks pg 17, lines 8-11). That is to say, there is no enhancement found in the claimed step other than the known advantage of increased speed/efficiency. Although it is true that addition and subtraction of numbers were traditionally done manually (i.e., using pen and paper), and have since been automated by inventions, for example, the calculator. However, If the inventors of the calculator merely claimed " an internet-based automatic system and method of performing mathematical manipulations of input numbers, comprising: addition, subtraction, division, and multiplication of said input numbers, and displaying the output results of said mathematical manipulations on the screen," with nothing more, they would have been rejected under ***In Re Venner***. However, the inventors of the calculator claimed the mechanized features, structure and construction of the machine, itself i.e., the central processing unit, the circuitry, the input pad, the display, and the inter-relationship of the parts as it relates to the input signal received; the processing of the input signal, and the display of the result of the manipulation/processing performed on the said input signal.

Regarding the rejection of claims 20, 26, and 34, the applicant argues in substance that the prior art of record, DE, does not disclose identifying whether vendors satisfy minimum attribute set by a buyer, as recited in claims 20, 26, and 34 above, but rather discloses products and factories of suppliers being evaluated by an independent organization. Contrary to the applicant's assertion, in the same column cited in the remarks by the applicant (i.e., DE col.2, lines 1-4), DE discloses that the structure and dynamics of the market to both buyers and suppliers are such that the need for intermediaries are eliminated. However, since buyers and suppliers may continue to require the services provided by third-parties, the services provided by third-parties, system 100 provides a transactional link through which the services can be retained. Thus, it is exceedingly clear that DE did not mention in the slightest, in col.2, lines 1-4, products and factories of suppliers being evaluated by an independent organization, contrary to the applicant's assertion in the remarks. More telling, DE system is preferably organized so that the third-party service providers are not able to interfere with the direct negotiations between buyers and suppliers (see para 0033).

The examiner further asserts that DE explicitly disclose identifying whether vendors satisfy minimum attribute set by a buyer i.e., remote buyers can develop RFQ's defining both the objective configurations (i.e., product type, package size, quantity, delivery equirements, etc.) and subjective characteristics (i.e., flavor, aroma, texture, etc.) of the product. The buyer then sends the RFQ to the

transaction facilitator for presentation to suppliers located throughout the world. In response, interested suppliers may develop quotations (also referred to herein as quotes or bids) to provide the product specified in the RFQ for a particular price. The suppliers' bids are sent to the transaction server subsystem for presentation to the buyer, who may accept a bid or make a counter-offer, see paras 0031-0032). Note that buyers activation of filter software to screen offers based on product type, supplier, country of origin, etc (see DE para 0032) constitute identifying whether vendors satisfy minimum attribute as claimed by the applicant.

The applicant further argues that DE does not disclose "registering vendors that satisfy minimum attributes." Contrary to the applicant's assertion, the examiner asserts that DE clearly makes this disclosure (Please see pg 3 of DE, para 0029, "Preferably, each buyer, supplier, and third-party service provider gains access or "membership" to system 100 by registering with the system operator. The system operator typically will collect information regarding the identity of the participant, the party's financial information, the goods/services in which the participant trades, and etc. This information may be stored in one or more databases 115 of transaction facilitator 102 for access by transaction server subsystem 112.").

The applicant further argues that DE fails to disclose a buyer's vendor selection criteria, as it is cited in the claims of the present application, and that according to the present invention, a buyer's vendor selection criteria includes

information used by the buyer in the selection of a vendor, for example, geographic region, business type, price etc. The examiner asserts that DE makes this disclosure (i.e., buyers can activate software filters to screen offers based on product type, supplier, country of origin, etc (see DE para 0032).

Lastly, the applicant argues that DE does not disclose an engine to select a qualified vendor for the buyer based on the database information and selection criteria, as recited in claim 26 of the present application. The examiner asserts that software filters, disclosed by DE to screen offers based on product type, supplier, country of origin, constitute an engine to select a qualified vendor for the buyer, as disclosed by the applicant. Selection engine as used in the present situation is nothing but a software written to perform a selection task, and this is exactly what DE disclosed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

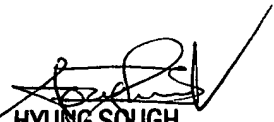
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HYUNG S. SOUGH can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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